

REMARKS

At the time of the Office Action dated February 12, 2004, claims 1-28 were pending. Of those claims, claims 9-17 and 26-28 have been withdrawn from consideration pursuant to the provisions of 37 C.F.R. §1.142(b). Applicants acknowledge, with appreciation, the Examiner's indication that claims 5-8, 22 and 24 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 1-4, 18-21, 23 and 25 stand rejected.

In this Amendment, claims 1 and 18 have been amended only for better form, but their scopes are not narrowed for any reason relating to patentability. No new matter is introduced.

Claims 1, 2, 18 and 19 have been rejected under 35 U.S.C. §102(e) as being anticipated by Hirai et al.

In the statement of the rejection, the Examiner asserted that Hirai et al. discloses an apparatus for editing moving picture corresponding to what is claimed. This rejection is respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of the claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F. 3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

Based on Applicants' review of Hirai et al., it is submitted that the reference does not disclose a method of measuring the surface motion of each portion of an object surface and a computer data signal including all the limitations recited in independent claims 1 and 18. In other words, there are significant differences between the claimed invention and an apparatus disclosed by Hirai et al. that defeat the factual determination that Hirai et al. identically describes the claimed invention within the meaning of 35 U.S.C. §102.

Hirai et al. is directed to an apparatus for editing a moving picture having related information thereof. The Hirai apparatus includes a scene change point detector 201 (Fig. 2) for detecting change points of the moving picture and dividing the moving picture into scenes and cuts. The apparatus arranges the divided scenes in a hierarchical structure to manage them (see Fig. 1 with the related information (e.g., column 9, lines 6-10)).

Specifically, Applicants submit that Hirai et al. does not disclose the steps of “determining a plurality of measurement points in an image of said object of a first unit image...,” and “determining the points in said object image of said second unit image, corresponding to the measurement points of said first unit image....,” recited in claims 1 and 18 (emphasis added).

In the statement of the rejection, the Examiner asserted that “the scene change point detector 201 in Figure 2 determines a plurality of points in an image frame(s).” However, the Examiner's interpretation of Hirai's description is unreasonable. Hirai et al. discloses as follows: “The scene change point detector 201 digitizes the received moving picture, and analyzes color distribution information between images thereof to detect a scene change point and a cut change point” (emphasis added) (column 8, lines 32-35). It is apparent that the “scene change point” and “cut change point” are not a point in an image frame, but refer

to possible breaking points of a stream of frames based on predetermined views or prospects (see the “scene change point detector” 201 in Fig. 11 explaining its function). According to the context of Hirai et al., there is no reason to recognize that the “scene change point” and “cut change point” are *in* an image frame, as claimed in claims 1 and 18.

Further, Hirai et al. does not disclose the step of “repeating, starting from a level immediately upper than the lowest level to the highest level, the determination of the points corresponding to the measurement points...,” recited in claims 1 and 18.

The Examiner asserted that “the process is repeated for determining points in the images as seen in Figure 12” by citing column 10, line 56 to column 11, line 34; and Figure 30 of Hirai et al. However, Figure 12 of Hirai et al. simply shows “memory areas for storing therein related information and M-icon information associated therewith” (column 5, lines 60-62). In other words, the Examiner’s cited portion merely explains the hierarchical structure of scenes with their related information. As to Figure 30, Hirai et al. states “FIG. 30 shows an example of how to set www page information” (column 6, lines 10-11; and see column 12, line 17+). Accordingly, there is no substantial evidence that Hirai et al. discloses what the Examiner asserted.

The above-described fundamental differences between the claimed invention and Hirai et al. undermine the factual determination that Hirai et al. identically describes the claimed invention within the meaning 35 U.S.C. §102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, respectfully submit that the imposed rejection of claims 1 and

18 under 35 U.S.C. §102(e) for lack of novelty as evidenced by Hirai et al. is not factually viable and, hence, solicit withdrawal thereof.

It is noted that a dependent claim is not anticipated if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claim.

Therefore, claims 2 and 19 are patentable because they respectively include all the limitations of independent claims 1 and 18. The Examiner's additional comments with respect to claims 2 and 19 do not cure the argued fundamental deficiencies of Hirai et al. Accordingly, Applicants respectfully solicit withdrawal of the rejection of claims 2 and 19, and favorable consideration thereof.

Claims 3, 4, 20, 21, 23 and 25 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Hirai et al. in view of Deutsch et al.

In the statement of the rejection, the Examiner asserted that the proposed combination of Hirai et al. and Deutsch et al. teach or suggest what is claimed in the claims. Applicants respectfully traverse this rejection.

In imposing a rejection under 35 U.S.C. §103, the Examiner is required to make a "thorough and searching" factual inquiry and, based upon such a factual inquiry, explain why one having ordinary skill in the art would have been realistically impelled to modify particular prior art, in this case Hirai's particular apparatus, to arrive at the claimed invention. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Merely identifying features of a claimed invention in disparate prior art references does not, automatically, establish the requisite motivation for combining references in any particular

manner. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999); *Grain Processing Corp. v. American-Maize Products Co.*, 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988).

In applying the above legal tenets to this case, it is apparent that the Examiner has not established the requisite motivational element. According to the Examiner, “Hirai and Deutsch are combinable because they are from the same field of endeavor, i.e., editing images.” The Examiner’s asserted motivation is Deutsch’s suggestion that “To understand this representation, it is helpful to visualize the image as a three-dimensional surface, with the depth of the surface given by the intensity value of each pixel, as explained in connection with FIG. 3C” (column 9, lines 56-60). The Examiner’s cited portion is related to FIG. 4D of Deutsch et al. depicting “the slope detection process, which determines if the pixel values from the source image encompassed by the tile can be represented as a slope expression” (column 9, lines 53-56). On the other hand, operation of Hirai’s apparatus is to divide a moving picture into scenes, arranges the scenes in a hierarchal structure together with related information thereof, and manage them. Applicants submit that Hirai’s apparatus does not need to employ such a process taught by Deutsch et al., and the Examiner did not provide any substantial evidence as to why a person having ordinary skill in the art is motivated to modify Hirai’s apparatus based on the teachings of Deutsch et al. Therefore, there is no motivation to modify Hirai’s apparatus.

Applicants further submits that to establish to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The proposed combination of Hirai

et al. and Deutsch et al. does not teach or suggest each and every limitation of claims 3, 4, 20, 21, 23 and 25.

As discussed above, Hirai et al. does not disclose all the limitations recited in independent claims 1 and 18 upon which claims 3, 4, 20, 21, 23 and 25 depend. Moreover, Deutsch et al. does not teach or suggest all the limitations recited in independent claims 1 and 18, either. Deutsch et al. is related to a technique for developing an analytic model of an image by operating directly upon pixel map representation output by an optical sampling device, such as a scanner. Therefore, citing Deutsch et al. does not cure fundamental deficiencies of Hirai et al. since Deutsch et al. is silent on, for example, the step of “determining a plurality of measurement points in an image...,” recited in claim 1.

Accordingly, the proposed combination of Hirai et al. and Deutsch et al. does not teach or suggest all the limitations recited in claims 3, 4, 20, 21, 23 and 25.

Based upon the foregoing, Applicants submit that the Examiner has not established a *prima facie* basis to deny patentability to the claimed invention for lack of the requisite factual basis and want of the requisite realistic motivation. Applicants, therefore, respectfully submit that the imposed rejection of claims 3, 4, 20, 21, 23 and 25 under 35 U.S.C. §103 for obviousness predicated upon Hirai et al. in view of Deutsch et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Conclusion.

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might

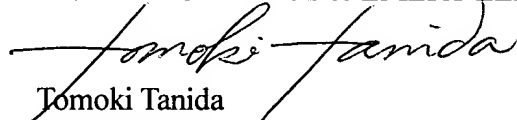
09/712,250

be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY-LLP


Tomoki Tanida
Recognition under 37 C.F.R. 10.9(b)

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 SAB:TT:lnm
Facsimile: (202) 756-8087
Date: June 14, 2004

BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATE PATENT AND TRADEMARK OFFICE



LIMITED RECOGNITION UNDER 37 CFR § 10.9(b)

Tomoki Tanida is hereby given limited recognition under 37 CFR § 10.9(b), as an employee of the law firm of McDermott, Will & Emery, to prepare and prosecute patent applications wherein the patent applicant is a client of the law firm of McDermott, Will & Emery, and a registered practitioner, who is a member of the law firm of McDermott, Will & Emery, is the practitioner of record in the applications. This limited recognition shall expire on the date appearing below, or when whichever of the following events first occurs prior to the date appearing below: (i) Tomoki Tanida ceases to lawfully reside in the United States, (ii) Tomoki Tanida's employment with the law firm of McDermott, Will & Emery, ceases or is terminated, or (iii) Tomoki Tanida ceases to remain or reside in the United States on an H-1B visa.

This document constitutes proof of such limited recognition. The original of this document is on file in the Office of Enrollment and Discipline of the U.S. Patent and Trademark Office.

Expires: July 24, 2004

RECEIVED

JUN 23 2004

A handwritten signature in dark ink, appearing to read "Harry I. Moatz", written over a horizontal line.

Harry I. Moatz

Director of Enrollment and Discipline

Technology Center 260